

### **REMARKS/ARGUMENTS**

Applicant appreciates the thorough examination of the present application, as evidenced by the first Official Action. The first Official Action rejects all of the pending claims, namely Claims 1-196 under 35 U.S.C. § 112, second paragraph, as being indefinite; and under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2006/0155873 to Twata et al., in view of alleged admitted prior art from the specification of the present application. As explained below, however, Applicant respectfully submits that the claimed invention is in fact definite under § 112, second paragraph; and patentably distinct over Twata in view of any alleged admitted prior art. Nonetheless, Applicant has amended various ones of the claims to further clarify the claimed invention. In view of the amendments to the claims and the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application.

#### ***A. Claims 1-196 are Definite***

The Official Action rejected all of the claims under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Official Action alleges that claim language such as “configured to” and “capable of” is optional language and lacks positive recitations. Applicant submits, however, that functional language, such as “configured to” and “capable of” is definite within the terms of 35 U.S.C. § 112, second paragraph. As such, Applicant respectfully traverses the rejection of the claims under 35 U.S.C. § 112, second paragraph. Applicant does note, however, that a number of the claims have been amended to remove the allegedly offending language.

Section 2173.05(g) of the MPEP defines a functional limitation as “an attempt to define something by what it does, rather than what it is (e.g., as evidenced by its specific structure or specific ingredients).” In this regard, a functional limitation is often used in association with an element to “define a particular capability or purpose that is served by the recited element, ingredient or step.” *Id.* (emphasis added). Such functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210 (CCPA 1971). As such, a functional

limitation must be evaluated and considered just as any other limitation of a claim. MPEP § 2173.05(g).

In numerous decisions, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) has held that functional language is definite within 35 U.S.C. § 112, second paragraph. For example, in *In re Barr*, 444 F.2d 956 (C.C.P.A. 1976), the court held that the language “incapable of forming a dye with said oxidizing developing agent” does comply with 35 U.S.C. § 112, second paragraph. The court found that such language, while functional, does set definite boundaries on the patent protection sought. The court has also held that the limitations “adapted to be fitted,” “adapted to be affixed” and “adapted to be positioned,” were definite within the bounds of 35 U.S.C. § 112, second paragraph. *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976). In holding the language definite, the court found nothing wrong in defining the structures of components in terms of the interrelationship of the components or the attributes they must possess. *See* 530 F.2d at 959.

Also recognizing the appropriateness of functional language, the Board of Patent Appeals and Interferences has held that the use of functional language in patent claims is definite within 35 U.S.C. § 112, second paragraph. *Ex parte Brick*, Appeal No. 2000-1794 (May 15, 2001) (non-presidential opinion). In *Ex parte Brick*, the Examiner rejected various claims of the Applicant’s patent application as being indefinite under 35 U.S.C. § 112, second paragraph. The Examiner claimed that language such as “adapted to be” rendered the claim indefinite, citing *In re Hutchison*, 154 F.2d 135 (C.C.P.A. 1946), for the proposition that the language did not constitute a limitation in any patentable sense. Disagreeing with the Examiner, however, the Board found that there is nothing intrinsically wrong with the technique of using functional terminology to define claim elements. The Board thus found the language “adapted to be” definite within 35 U.S.C. § 112, second paragraph.

Applicant therefore respectfully submits that each respective claim that defines an element in terms of a function the element is “configured to” perform or “capable of” performing is definite within 35 U.S.C. § 112, second paragraph. As such, Applicant submits that the rejection of the claims under 35 U.S.C. § 112, second paragraph is therefore overcome.

***B. Claims 1-196 are Patentable***

The Official Action also rejects Claims 1-196 as being unpatentable over Twata, in view of alleged admitted prior art from the specification of the present application. Amended independent Claim 1 reads as follows:

*A method of transmitting information a communications network, comprising the steps of:  
receiving a request to transmit the information, said request including a service constraint;  
generating a requested transport constraint based on the service constraint;  
parsing contents of a bit-field-encoded record corresponding to a link in the communications network to determine whether the link supports the requested transport constraint, wherein the bit-field-encoded record comprises a field having a length of at least two bits, the at least two bits specifying a supported transport constraint; and  
if the requested transport constraint is compatible with the supported transport constraint, transmitting the information over the link.*

The Official Action appears to allege that Twata discloses the receiving, generating and transmitting steps of amended independent Claim 1. And while the Official Action concedes that Twata does not teach or suggest the parsing step, the Official Action alleges that the specification of the present application discloses prior art including the parsing step as having been proposed for use in an industry standard. The Official Action then alleges that one skilled in the art would have been motivated to modify Twata to include the parsing feature to disclose the claimed invention. Applicant respectfully disagrees, and submits that even if one could argue that Twata did disclose respective steps of the claimed invention, the specification of the present application does not support alleged admitted prior art for the parsing step; and even if it did, one skilled in the art would not have been motivated to combine their teachings as alleged.

***1. Bit-Field-Encoded Record***

Like Twata, Applicant respectfully submits that any alleged admitted prior art disclosed in the specification of the present application also does not support parsing contents of a bit-field-encoded record corresponding to a link in the communications network, as set forth by amended independent Claim 1. As support for this element of the claimed invention, the Official Action alleges that the specification of the present application discloses that a “32-bit mask-

encoded record has been proposed for use as an industry standard.” Official Action of March 21, 2007, page 2. Even considering the above passage of the specification disclosing a 32-bit mask-encoded record, however, amended independent Claim 1 includes a bit-field-encoded record. And as would readily be understood by those skilled in the art, a mask-encoded record is not the same as (nor may it reasonably be interpreted as the same as) a bit-field-encoded record.

Applicant therefore respectfully submits that, in contrast to amended independent Claim 1, neither Twata nor any alleged admitted prior art teach or suggest parsing contents of a bit-field-encoded record corresponding to a link in the communications network to determine whether the link supports the requested transport constraint, wherein the bit-field-encoded record comprises a field having a length of at least two bits, the at least two bits specifying a supported transport constraint. And as neither Twata nor any alleged admitted prior art teach the aforementioned parsing feature, the combination of Twata and any alleged admitted prior art likewise does not teach or suggest the feature.

## ***2. No Motivation to Combine***

Even if one could argue (albeit incorrectly) that the specification of the present application did disclose prior art including the aforementioned parsing feature as alleged, one skilled in the art would not in fact have been motivated to accordingly modify Twata to disclose the claimed invention. In this regard, the Official Action alleges that one skilled in the art would have been motivated to modify Twata “to conform to an industry standard.” Applicant notes, however, that nowhere does the specification of the present application teach or suggest that a 32-bit mask-encoded record (allegedly corresponding to the claimed bit-field-encoded record) has been standardized. Rather, the specification only discloses that a 32-bit mask-encoded record has been proposed for use as an industry standard. Pat. Appl., page 1, paragraph 0003; and page 4, paragraph 00011. And in fact, the three references cited for presenting such a proposal are all working documents that on their face explicitly state that “[i]t is inappropriate to use Internet-Drafts as reference material or to cite them other than as ‘work in progress.’” Thus, Applicant respectfully submits that one skilled in the art would not have been motivated to modify Twata to include the disclosed, proposed 32-bit mask-encoded record to conform to an

industry standard because at least at the time of the claimed invention, the 32-bit mask-encoded record was not in fact a standard.

Applicant therefore respectfully submits that amended independent Claim 1, and by dependency Claims 2-29, are patentably distinct from Twata and any alleged prior art from the specification of the present application, taken individually or in combination. Applicant also respectfully submits that amended independent Claims 30, 60, 90, 105, 136 and 166 set forth subject matter similar to that of amended independent Claim 1, including the aforementioned feature of a bit-field-encoded record. As such, Applicant submits that amended independent Claims 30, 60, 90, 105, 136 and 166, and by dependency Claims 31-59, 61-89, 91-104, 106-135, 137-165 and 167-196, are also patentably distinct from Twata and any alleged prior art from the specification of the present application, taken individually or in combination, for at least the reasons given above with respect to amended independent Claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1-196 as being unpatentable over Twata, in view of alleged admitted prior art from the specification of the present application, is overcome.


Appl. No.: 10/632,613  
Amdt. dated June 21, 2007  
Reply to Official Action of March 21, 2007

### **CONCLUSION**

In view of the amendments to the claims and the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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